REMARKS

Status of the claims

Upon entry of these remarks, claims 1-48 will be pending in this application. Claims 19-47 have been provisionally elected, *with traverse.*

New claims 25-84 find support in the claims as originally filed and throughout the specification. More particularly, support for new claims can be found in the specification, for example, as follows: page 144, line 21 to page 145, line 10 and Example 27 (inhibiting binding of Endokine-alpha to endogenous cell surface Endokine-alpha receptors); page 158, lines 18-20 (inhibiting T cell migration across endothelial cells); page 8, lines 1-31 and page 61, lines 16-19, (polypeptide fragments of TR11, TR11SV1, and TR11SV2); Example 22-page 211, lines 5-11 (pharmaceutically acceptable carriers); and Examples 1, 8, 27, and 28 (heterologous polypeptide fusions). Thus, no new matter has been added by way of amendment.

Provisional Election with Traverse

The Examiner has required restriction of the claims into one of five groups - Group I drawn to nucleic acids, method of making vectors, vectors, method of making host cells, host cells, and method of making a polypeptide represented by claims 1-13; Group II drawn to polypeptides represented by claim 14; Group III drawn to antibodies, represented by claim 15, Group IV drawn to methods of treatment represented by claims 16 and 17, and Group V drawn to methods of screening for agonists and antagonists represented by claim 18. Additionally, the Examiner has further required that upon election of Groups I, II or III, that the Applicants must also elect a nucleic acid, polypeptide or antibody corresponding to TR11, TR11SV1 or TR11SV2.

In response, and pursuant to MPEP § 818.02(a), Applicants provisionally elect, *with traverse*, the subject matter of new claims 19-47 (but not new claim 48, see below), drawn to methods of inhibiting TR11-endokine-alpha interaction, for further prosecution. Applicants submit that the subject matter of new claims 19-47 (and 48) while fully supported by the specification as filed, does not fall within the scope of the Groups defined by the Examiner in the Office Action, but nonetheless form a single group of claims organized according to the scheme set forth by the Examiner in the Restriction Requirement. Under MPEP § 818.02(a) though, an election may be made by the presentation of original claims. Applicants reserve the right to file one or more divisional applications directed to non-elected groups should the restriction requirement be made final.

Applicants respectfully traverse the restriction requirement. The Examiner asserts that the claimed subject matter of the specified groups are distinct. Even assuming, for the sake of the argument, that patentably distinct inventions appear in a single application, restriction remains improper unless it can be shown that the search and examination of the groups together would entail a "serious burden" (see MPEP § 803). Applicants disagree with The Examiner's assertion that it would impose an undue burden to examine the nucleic acid, polypeptide, antibody, and method claims together.

Applicants submit the searching the claims together would ease the Examiner's burden because the searches for the different groups are overlapping. Applicants submit that a search of the polynucleotide claims would clearly provide useful information for the polypeptide claims. For example, in many, if not most, publications where a published nucleotide sequence contains an open reading frame, the authors also include, as a matter of routine, the deduced amino acid sequence. Thus, the searches for polynucleotides and polypeptides commonly overlap. Even in

the relatively uncommon case where a publication contains a nucleotide sequence which is not accompanied by the corresponding deduced amino acid sequence, it is routine for one to determine the corresponding amino acid sequence.

Moreover, a search for TR11 polypeptides (e.g., TR11, TR11SV1 and TR11SV2) would include, also as a matter of routine, a search for antibodies specific for TR11. Similarly, a search of TR11 polynucleotides and/or polypeptides of would include, also as a matter of routine, a search for methods of using TR11 (e.g., subject matter of Groups IV and V, and newly added claims 19-47). Thus, the search and examination of TR11 polynucleotides, corresponding TR11 polypeptide sequences, antibodies specific for the TR11 polypeptide sequences, and methods of using TR11 polynucleotides, TR11 polypeptides, and anti-TR11 antibodies would not entail a serious burden.

Further, Applicants respectfully disagree with the Examiner's requirement that claims in Groups I, II or III be restricted to TR11, TR11SV1 or TR11SV2. Applicants note that this requirement to elect one of TR11, TR11SV1 and TR11SV2 was applied only to Groups I, II, and III. However, as Groups IV and V refer back to the polypeptides of Group II, Applicants assume the Examiner meant to apply this restriction to Groups IV and V as well, and would also accordingly apply the same restriction to elected claims 19-48. Thus, in order to expedite prosecution of this case, Applicants provisionally elect, *with traverse*, the polypeptides corresponding to TR11 (SEQ ID NO:2) in newly presented claims 19-47 (omitting new claim 48 which is directed to methods of using TR11SV1 and TR11SV2).

In support of this traversal, Applicants respectfully direct the Examiner to M.P.E.P. § 803.04, which states:

> Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 *et seq*. Nevertheless, to further aid the bio-technology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of 37 CFR 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application. See *Examination of Patent Applications Containing Nucleotide Sequences,* 1192 O.G. 68 (November 19, 1996).
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> It has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction.

Applicants therefore request that the Examiner withdraw the requirement to elect one of TR11, TR11SV1, and TR11SV2 and, instead, consider for TR11, TR11SV1, and TR11SV2 together.

Accordingly, Applicants respectfully request that the restriction requirement be withdrawn.

CONCLUSION

Applicants respectfully request that the remarks above be entered and made of record in the file history of the instant application.

Respectfully submitted,

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